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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,923	08/20/2003	Timothy Bateman	0119/0025	8218
21395	7590	06/29/2004	EXAMINER	
LOUIS WOO LAW OFFICE OF LOUIS WOO 717 NORTH FAYETTE STREET ALEXANDRIA, VA 22314			GILBERT, SAMUEL G	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/643,923	Applicant(s) BATEMAN ET AL.	
	Examiner Samuel G Gilbert	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15 and 16 is/are allowed.
- 6) ☒ Claim(s) 1-11, 13, 14, 17 and 20 is/are rejected.
- 7) ☒ Claim(s) 12, 18 and 19 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/15/2004 and 2/17</u> . | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Information Disclosure Statement

The information disclosure statements filed 4/15/2004 and 2/17/2004 have been considered. DE 739,098 has not been considered because the concise explanation of relevance has not been provided and the document is not in English.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 10, 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Bateman et al (5360389).

Claim 1 - Bateman teaches a tube -42- and an elongate jacket -44-.

Claim 2 – the jacket is flexible column 4 line 50-60.

Claim 3 – the jacket is inherently thermally insulating.

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Claim 10 – the claim is a product by process type claim. In view of the fact that the end products are identical the method of manufacturing the product does not supply any patentable weight.

Claims 11 – the syringe can contain a sterile solution, a flushing fluid, column 7 lines 52-56.

Claim 13 – tube -42- is capable of passing an oocyte or an embryo.

Claims 1-11, 13, 14, 17 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Rosenman (6,488,659).

Claims 1 and 13 - applicant's attention is invited to figures 2-4, three embodiments that read on claim 1. The examiner is taking element -14- as a tube and elements -13- or tubes -18- and -19- to form the jacket. Tube -14- is capable of passing an oocyte or embryo.

Claims 2-4 - the jacket is flexible, insulating and made of foamed plastic column 3 lines 53-67.

Claims 5-7 and 20 – tubes -18- and -19- carry heated solution, column 5 lines 1-10.

Claim 8 - tubes -18- and -19- are circular. The examiner is taking the circular tubes to be two c-shaped lumens connected together to form a circle.

Claim 9 – the inlet and outlets are at the same end of the tube.

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Claim 10 – the claim is a product by process type claim. In view of the fact that the end products are identical the method of manufacturing the product does not supply any patentable weight.

Claims 11 – element -5- is a source of flushing fluid. Further the source of fluid connected to lumen -16- is also a source of flushing fluid.

Claim 14 – the examiner is taking lumen -14- to be an aspiration lumen and lumen -16- to be a flushing lumen as shown in figure 2 jacket -13- extends around both the aspiration lumen and the flushing lumen.

Claim 17 – the examiner is taking the portion of the insulating jacket closest to lumen -14- as a first insulating jacket and the portion of the jacket closest to lumen -16- as the second insulating jacket.

Allowable Subject Matter

Claims 12, 18, and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 15 and 16 are allowed.

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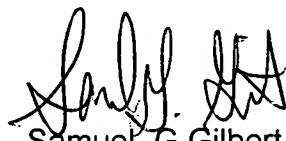
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patents 3,971,383; 4,399,319; and 4,399,319; and USPGPUB 2004/0024392 teach related insulated devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G Gilbert whose telephone number is 703-308-3553. The examiner can normally be reached on M-F 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mary Beth Jones can be reached on 703-308-3400. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Samuel G Gilbert
Primary Examiner
Art Unit 3736

sgg